



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,420	07/25/2000	George G. Neuman	P/3458-2	6646

2352 7590 11/28/2006

OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK, NY 100368403

EXAMINER
----------

FRENEL, VANEL

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/625,420

Applicant(s)

NEUMAN, GEORGE G.

Examiner

Vanel Frenel

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Appeal Brief filed on 9/24/06. Claims 1-48 are pending.

2. In view of the Appeal Brief filed on 9/20/06, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 C.F.R 1.111 (if this Office action is non-final) or a reply under 37 C.F.R 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplement appeal brief, but no new amendments, affidavits (37 C.F.R 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 C.F.R 1.193) (b) (2).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 17 and 33 recite the limitations of: "receiving a diagnosis provided by a consumer or an alternative diagnosis determiner". It is unclear as to what kind of receiving a diagnosis provided by a consumer or an alternative diagnosis determiner" Applicant's is referring to. Claim 33 recites a computer readable storage medium for a program operating a system to match a consumer... and furthermore Applicant's reiterates the computer readable storage medium comprising a computer program comprising: It is unclear to the Examiner as to what kind of "computer program comprising" Applicant's is referring to. Appropriate correction is needed.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-48 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method; a machine (or system); an article of manufacture; or a composition of matter.

(A) Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangibly result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

In the present case, the claimed invention allowing the consumer to select a treatment from the at least one treatment option and automatically determining at least

one appropriate service provider for the selected treatment (i.e., repeatable or concrete) that can be based on a treatment preference (i.e., useful).

However, for a claimed invention to be statutory it must also produce a tangible result. It is respectfully submitted that in this present case, claims 1, 17 and 33 do not have a tangible result, as there is no tangibly result, as there is no tangibly embodied real-world outcome or consequence that results from the method steps or the system or the software product, and thus the invention fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C 101.

In light of the above, it is respectfully submitted that the claimed invention, although useful and concrete, is not tangible, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-48, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over De Bruin-Ashton (6,014,629) in view of Joao (6,283,761).

(A) As per claim 1, Bruin-Ashton discloses a system to match a consumer of health care services to a health care service provider over a communications network (Fig.1; Col.6, lines 39-67), the system comprising:

at least one computer terminal associated with the consumer for allowing the consumer access to the communications network (Fig.1; Col.6, lines 39-67);

a network server coupled to the communications network, the server comprising a computer program (Col.7, lines 15-33) having:

a service provider data base identifying a plurality of health care service providers and a plurality of medical service associated health care service products offered by the service providers (Col.12, lines 37-67).

Bruin-Ashton does not explicitly disclose a first software portion for receiving a diagnosis provided by a consumer or an alternative diagnosis determiner and automatically determining at least one treatment option based on the received diagnosis provided by the consumer or determined by the alternative diagnosis determiner; and

a second software portion for allowing the consumer to select a treatment from the at least one treatment option and

automatically determining at least one appropriate service provider for the selected treatment, based on selected treatment and further based on a treatment preference, the treatment preference comprising at least one of: geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option and provider outcome with respect to the at least one treatment option.

However, these features are known in the art, as evidenced by Joao. In particular, Joao suggests a first software portion for receiving a diagnosis provided by a

consumer or an alternative diagnosis determiner (See Joao, Col.26, lines 10-61) and automatically determining at least one treatment option based on the received diagnosis provided by the consumer or determined by the alternative diagnosis determiner (See Joao, Col.26, lines 20-43); and

a second software portion for allowing the consumer to select a treatment from the at least one treatment option (See Joao, Col.36, lines 59 to Col.37, line 9) and automatically determining at least one appropriate service provider for the selected treatment, based on the selected treatment and further based on a treatment preference, the treatment preference comprising at least one of: geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option and provider outcome with respect to the at least one treatment option (See Joao, Col.30, lines 48- Col.31, line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Joao within the system of DeBruin-Ashton with the motivation of performing healthcare and/or healthcare-related diagnoses, to provide healthcare and/or healthcare-related expected prognoses, to provide healthcare and/or healthcare-related treatment plans or programs, and/or to provide healthcare and/or healthcare-related treatment progress reports and/or evaluations (See Joao, Col.4, lines 42-47).

(B) As per claim 2, Joao discloses the system wherein the service provider data base comprises information related to a plurality of service providers, medical products offered by each provider, the provider's experience with each medical product, outcome

of each provider with respect to each product, price for each product, description of each product and demographic location of each provider (Col.17, lines 63-Col.18, line 20; Col.19, lines 40-50; Col.31, lines 25-30).

The motivation for combining the respective teachings of DeBruin-Ashton and Joao are as discussed above in the rejection claim 1, and incorporated herein.

(C) As per claim 3, Joao discloses the system further wherein the first software portion automatically determines the number of treatment options based on the diagnosis (Col.25, lines 63-67 to Col.26, line 10).

The motivation for combining the respective teachings of DeBruin-Ashton and Joao are as discussed above in the rejection claim 1, and incorporated herein.

(D) As per claim 4, Joao discloses the system wherein the first software portion allows selection of treatment option if more than one treatment option is available (Col.26, lines 20-38).

The motivation for combining the respective teachings of DeBruin-Ashton and Joao are as discussed above in the rejection claim 1, and incorporated herein.

(E) As per claim 5, Joao discloses the system wherein the alternative diagnosis determiner comprises one of a link to a medical diagnosis database and a referral to a physician (Col.19, lines 12-20; Col.30, lines 55-60).



The motivation for combining the respective teachings of DeBruin-Ashton and Joao are as discussed above in the rejection claim 1, and incorporated herein.

(F) As per claim 6, Joao discloses the system wherein the first software portion accesses the service provider database to describe the treatment option when more than one treatment option is available (Col.26, lines 20-38).

The motivation for combining the respective teachings of DeBruin-Ashton and Joao are as discussed above in the rejection claim 1, and incorporated herein.

(G) As per claim 7, Joao discloses the system wherein the first software portion allows the consumer to obtain a referral to a physician to assist in understanding of treatment options (Col.30, lines 55-60).

The motivation for combining the respective teachings of DeBruin-Ashton and Joao are as discussed above in the rejection claim 1, and incorporated herein.

(H) As per claim 8, DeBruin-Ashton discloses the system wherein, after the consumer is matched to a service provider, an identification number is issued (Col.4, lines 16-47).

(I) As per claim 9, DeBruin-Ashton discloses the system further comprising a link to the service provider (Col.6, lines 39-55).

(J) As per claim 10, DeBruin-Ashton discloses the system further comprising a consumer database obtained from the second software portion comprising information related to the consumer's choice of service provider (Col.1, lines 22-39).

(K) As per claim 11, DeBruin-Ashton discloses the system wherein the consumer database is coupled to the service provider database for updating the service provider database (Col.2, lines 60-67).

(L) As per claim 12, DeBruin-Ashton discloses the system wherein the second software portion has an input from the service provider database to determine the at least one appropriate service provider (Col.3, lines 1-23).

(M) As per claim 13, DeBruin-Ashton discloses the system wherein provider outcome includes an indication of consumer satisfaction (Col.11, lines 60-67 to Col.12, line 18).

(N) As per claim 14, DeBruin discloses the system further wherein the cost treatment preference includes the capability to offer a reduced cost for greater usage (Col.1, lines 22-39).

(O) As per claim 15, DeBruin-Ashton discloses the system further comprising the capability to prioritize the treatment preferences in a selected order (Col.1, lines 48-67).

(P) As per claim 16, DeBruin-Ashton discloses the system further comprising a program flow for charging the consumer a fee to participate in the system (Col.1, lines 22-39).

(Q) Claim 17 differs from claim 1 by reciting a method to match a consumer of health care services to a healthcare service provider over a communications network.

As per this limitation, it is noted that DeBruin-Ashton discloses allowing the consumer to access the communications network to connect to a network server coupled to the communications network (See Fig.1; Col.6, lines 39-67), the server comprising a computer program having a service provider data base identifying a plurality of health care service providers and a plurality of medical service associated health care service products offered by the service providers (See DeBruin, Figs.3 A-3B; Col.14, lines 24-42);

automatically determining with the computer program at least one appropriate service provider for the selected treatment, based on the selected treatment and further based on a treatment preference, the treatment preference comprising at least one of geographical location of the provider (See DeBruin-Ashton; Col.7, lines 15-67; Col.8, lines 15-65) and Joao discloses receiving a diagnosis provided by a consumer or an alternative diagnosis determiner (See Joao, Col.26, lines 20-43); automatically determining with the computer program at least one treatment option based on the received diagnosis provided by the consumer or determined by an alternative diagnosis determiner (See Joao, Col.26, lines 20-43); allowing the consumer to select a treatment

from the at least one treatment option; insurance plan participation, cost, provider experience with the at least one treatment option, and provider outcome with respect to the at least one treatment option (See Joao, Col.24, lines 12-21; Col.37, lines 22-30).

Thus, it is readily apparent that these prior art systems utilize a method to match a consumer of health care services to a healthcare service provider over a communications network to perform their specified function.

The remainder of claim 17 is rejected for the same reason given above for claim 1, and incorporated herein.

(R) Claims 18-32 recite the underlying process steps of the elements of claims 2-16, and respectively. As the various elements of claims 2-16 have been shown to be either disclosed by or obvious in view of the collective teachings of DeBruin-Ashton and Joao, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 18-32 are rejected for the same reasons given above for system claims 1-16, and incorporated herein.

(S) Claim 33 differs from claims 1 and 17 by reciting a computer readable storage medium for a program for operating:

As per this limitation, it is noted that DeBruin-Ashton discloses a system to match a consumer of health care services to a health care service provider over a communication network coupling at least one computer terminal associated with the consumer for allowing the consumer access to the computer network and a network

server (Col.7, lines 1-62; Col.8, lines 15-65), the computer readable storage medium comprising a computer program comprising:

a service provider data base identifying a plurality of health care service providers and a plurality of medical service associated health care service products offered by the service providers (Col.7, lines 1-62) and Joao discloses a first software portion for receiving a diagnosis provided by a consumer or an alternative diagnosis determiner and automatically determining at least one treatment option based on the received diagnosis provided by the consumer or determined by the alternative diagnosis determiner (See Joao, Col.26, lines 20-43); and a second software portion for allowing the consumer to select a treatment from the at least one treatment option; and automatically determining at least one appropriate service provider for the selected treatment, based on the selected treatment and further based on a treatment preference, the treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option and provider outcome with respect to the at least one treatment option (See Joao, Col.24, lines 12-21; Col.37, lines 22-30).

Thus, it is readily apparent that these prior art systems utilize a computer readable storage program to perform their specified function.

The remainder of claim 33 is rejected for the same reason given above for claims 1 and 17, and incorporated herein.

(T) Claims 34-48 recite the underlying process steps of the elements of claims 2-16, and respectively. As the various elements of claims 2-16 have been shown to be either disclosed by or obvious in view of the collective teachings of DeBruin-Ashton and Joao, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 34-48 are rejected for the same reasons given above for system claims 1-16, and incorporated herein.

### ***Response to Arguments***

9. Applicant's arguments filed 09/14/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 09/14/06.

(A) At pages 2-11 of the 09/14/06 response, Applicant argues that the features in the 09/14/06 appeal brief are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features in the 09/14/06 appeal brief, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of DeBruin-Ashton and Joao, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method and apparatus for objectively monitoring and assessing the performance of health-care providers based on the severity of sickness episodes treated by the providers (5,845,254) and delivery of medical services using electronic data communications (5, 619,991).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday- Thursday from 6:30 am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-7667. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3627

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

V.F  
V.F

November 22, 2006

Andrew Joseph Rudy  
Primary Examiner, AU 3627